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**MAILED**

**NOV 23 2009**

In re Application of

Tuschl et al.

Application No. 09/821,832

Filed: March 30, 2001

Attorney Docket No. 0399.2008-002

**OFFICE OF PETITIONS**

**ON PETITION**

This is a decision on the request for reconsideration filed October 22, 2009 on behalf of Whitehead Institute for Biomedical Research (Whitehead), Massachusetts Institute of Technology (M.I.T.), and the University of Massachusetts (UMass). The petition filed October 22, 2009 requests that the USPTO vacate the decision on the petitions filed under 37 CFR §§ 1.36(a) and 1.183 granting revocation of power of attorney and waiver of the requirement of 37 CFR 1.32(b)(4) for appointment of power of attorney by less than all of the applicants or owners. This decision also addresses the response in opposition filed November 2, 2009 on behalf of Max-Planck-Gesellschaft Zur Forderung Der Wissenschaften E.V. (Max-Planck).

The request for reconsideration is **DISMISSED**.

The decision mailed September 3, 2009 by the USPTO indicated that due to the existing conflict of interest between the parties "...a clear determination by an appropriate authority regarding representation of the parties in the instant application" was required before any party would gain the sole right to control the case. Petitioner now submits a decision by the U.S. District Court for the District of Massachusetts on a requested preliminary injunction to establish the representation of the parties. However the decision is not a clear determination regarding representation of the parties.

The District Court's decision mostly focused on issues unrelated to representation in the above-identified application, with only some discussion of representation. Whitehead's responsibility for prosecuting Tuschl I application, with good-faith consideration of Max-Planck's comments and advice, was discussed. In addition, the last paragraph on page 15 through the first full paragraph on page 16 of the decision is relevant to the matter of representation in that those paragraphs consider the contractual agreements related to representation. However, the decision did not give a clear interpretation of the agreement regarding representation of the above-identified application. Rather, the decision indicated that Max-Planck does not have "veto power" over Whitehead's decisions on prosecution, which is recognized as a different matter

than that before the USPTO in this application. Moreover, the decision was only on a preliminary injunction considering Max-Planck's likelihood of success on the merits without resolving the matters of representation. A clear determination regarding representation of the parties cannot be found in the decision.

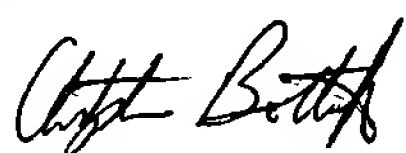
Furthermore, the Office is not persuaded by the contention that permitting Max-Planck to choose its own counsel under the circumstances amounts to granting Max-Planck "veto power" over the application. This contention presumes that Max-Planck will not cooperate in the prosecution of the application and force its abandonment, which is speculation. Also, in the event that such a scenario should unfold, the application may be revived under 37 CFR 1.137 after a clear determination regarding representation of the parties is given by an appropriate authority and power of attorney in the application is changed accordingly. While such abandonment may delay prosecution, it does not have to prevent its completion. For the same reason, the alternative request to stay the decision on Power of Attorney is dismissed. The parties will not be permitted to exclude Max-Planck from prosecution until the issues of representation are clearly resolved by an appropriate authority.

As discussed in the decision mailed September 3, 2009 by the USPTO, the revocation and appointment of new counsel applies only to Max-Planck and those to whom it's right, title and interest are assigned. The practitioners of Wolf Greenfield & Sacks, P.C may continue to represent the other co-assignees.

In order to assure that all interests are properly and effectively represented, further correspondence to the United States Patent and Trademark Office (USPTO) in this application – or resultant patent – must be signed by both: (1) a registered practitioner representing Max-Planck; and (2) a registered practitioner representing the interests of the other co-assignees. Any counsel when signing subsequent papers must indicate whom he or she represents.

The Technology Center is again advised that communications filed on or after September 3, 2009 not signed in accordance with the earlier petition decision must also be regarded as informal, and as such, to take the action it deems appropriate.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-6692.



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